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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,242	02/01/2002	Andrew Richard Wainwright	294-107 PCT/US	9497

7590

02/14/2006

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EXAMINER

BECKER, DREW E

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/936,242

Applicant(s)

WAINWRIGHT ET AL.

Examiner

Drew E. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:

- Disposition: 1) ☐ Certified copies of the priority documents have been received.
- 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

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**DETAILED ACTION****Response to Amendment**

1. The declaration under 37 CFR 1.132 filed December 16, 2005 is insufficient to overcome the rejection of claims 1-18 based upon Martines-Serna Villagran et al, in view of either Tallberg et al or Stahl, as set forth in the last Office action because: Dr. Buwalda merely states that Tallberg et al and Stahl do not mention increased expansion. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness. To overcome the rejection of claims 1-18 based upon Martines-Serna Villagran et al, in view of either Tallberg et al or Stahl, as set forth in the last Office action because: Dr.

**Claim Rejections - 35 USC § 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martines-Serna Villagran et al in view of Tallberg et al [Pat. No. 5,824,798].

In view of the foregoing, when all of the evidence is considered, the totality of the Martines-Serna Villagran et al teaches a snack product comprising potato flakes rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

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(column 10, lines 15-28), normal potato flakes comprising about 73-81% amylopectin (column 6, line 50), the preferred potato flakes having an increased amylopectin content of about 84% produced by blanching and pre-conditioning (column 7, line 31), the potato flakes comprising 78% of the snack product (column 21, line 25), cereal flours and normal potato starches (column 10, lines 40-63), additives such as emulsifiers (column 11, line 65), the snack products being fried, baked, or extruded (column 10, lines 15-28), Saturna variety of potatoes (column 4, line 28), less than 5% reducing sugars (column 11, line 50), and oil (column 17, line 30). Martines-Serna Villagran et al do not recite potato starch with an amylopectin content of at least 85%. Tallberg et al teaches a potato comprising starch with an amylopectin content of 100% (claim 1; column 1, lines 37-44). It would have been obvious to one of ordinary skill in the art to incorporate the high amylopectin potato of Tallberg et al into the invention of Martines-Serna Villagran et al since both are directed to food products, since Martines-Serna Villagran et al already taught the use of any commercially available potato (column 4, line 24), since Martines-Serna Villagran et al already used starch with a higher amylopectin content of about 84% (column 7, line 31), since the 100% high amylopectin potato starch of Tallberg et al has not been subjected to chemical modification, making it more suitable as a food ingredient (column 1, lines 37-44), and since the potato of Tallberg et al would have eliminated the need for blanching and pre-conditioning in Martines-Serna Villagran et al. The combined product of Martines-Serna Villagran et al and Tallberg et al would have inherently provided increased expansion due to its higher amylopectin content.

Martines-Serna Villagran et al already taught the use of any commercially available potato (column 4,

line 24), since Martines-Serna Villagran et al already used starch with a higher

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4. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madines-Serna Villagran et al, in view of Tallberg et al, as applied above, and further in view of Jeffcoat et al [Pat. No. 6,541,060].

Martines-Serna Villagran et al and Tallberg et al teach the above mentioned components. Martines-serna Villagran et al and Tallberg et al do not recite less than 10% pregelatinized waxy potato starch. Jeffcoat et al teach a food product comprising less than 10% pregelatinized waxy potato starch (column 13, Example 18). It would have been obvious to one of ordinary skill in the art to incorporate the less than 10% pregelatinized waxy potato starch of Jeffcoat et al into the invention of Madines-Serna Villagran et al, in view of Tallberg et al, since all are directed to food products, since Martines-Serna Villagran et al already included many different types of starches (column 10, lines 39-63), and since pregelatinized waxy potato starch was commonly used in food products, as shown by Jeffcoat et al (column 13, Example 18).

5. Claims 1-9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martines-Serna Villagran et al in view of Stahl [Pat. No. 5,759,597].  
Martines-Serna Villagran et al teaches a snack product comprising potato flakes (column 10, lines 15-28), the potato flakes comprising 78% of the snack product (column 21, line 25), normal potato flakes comprising about 73-81% amylopectin (column 6, line 50), the preferred potato flakes having an increased amylopectin content of about 84% produced by blanching and pre-conditioning (column 7, line 31), cereal flours and normal potato starches (column 10, lines 40-63), additives such as emulsifiers (column 11, line 65), the snack products being fried, baked, or extruded used in food products, as shown by Jeffcoat et al (column 13, Example 18).

6. Claims 1-9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable

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(column 10, lines 15-28), Saturna variety of potatoes (column 4, line 28), less than 5% reducing sugars (column 11, line 50), and oil (column 17, line 30). Martines-Serna Villagran et al do not recite potato starch with an amylopectin content of at least 85%. Stahl teaches a food product comprising potato starch with an amylopectin content of at least 95% (claims 1-2). It would have been obvious to one of ordinary skill in the art to incorporate the high amylopectin potato starch of Stahl into the invention of Martines-Serna Villagran et al since both are directed to food products, since Martines-Serna Villagran et al already taught the use of any commercially available potato (column 4, line 24); since Martines-Serna Villagran et al already used starch with a higher amylopectin content of about 84% (column 7, line 31), since the 95% high amylopectin potato starch of Stahl has not been subjected to chemical modification, making it more suitable as a food ingredient, and since the potato of Stahl would have eliminated the need for blanching and pre-conditioning in Martines-Serna Villagran et al. The combined product of Martines-Serna Villagran et al and Stahl would have inherently provided increased expansion due to its higher amylopectin content.

6. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martines-Serna Villagran et al, in view of Stahl, as applied above, and further in view of Jeffcoat et al [Pat. No. 6,541,060].

Martines-Serna Villagran et al and Stahl teach the above mentioned components.

Martines-Serna Villagran et al and Stahl do not recite less than 10% pregelatinized waxy potato starch. Jeffcoat et al teach a food product comprising less than 10% pregelatinized waxy potato starch (column 13, Example 18). It would have been obvious to one of ordinary skill in the art to incorporate the waxy potato starch of Jeffcoat et al into the invention of Martines-Serna Villagran et al and Stahl since both are directed to food products, since Martines-Serna Villagran et al already taught the use of any commercially available potato (column 4, line 24); since Martines-Serna Villagran et al already used starch with a higher amylopectin content of about 84% (column 7, line 31), since the 95% high amylopectin potato starch of Stahl has not been subjected to chemical modification, making it more suitable as a food ingredient, and since the potato of Stahl would have eliminated the need for blanching and pre-conditioning in Martines-Serna Villagran et al. The combined product of Martines-Serna Villagran et al and Stahl would have inherently provided increased expansion due to its higher amylopectin content.

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to one of ordinary skill in the art to incorporate the less than 10% pregelatinized waxy potato starch of Jeffcoat et al into the invention of Martines-Serna Villagran et al, in view of Stahl, since all are directed to food products, since Martines-Serna Villagran et al already included many different types of starches (column 10, lines 39-63), and since pregelatinized waxy potato starch was commonly used in food products, as shown by Jeffcoat et al (column 13, Example 18).

### **Response to Arguments**

Applicant's arguments filed December 16, 2005 have been fully considered but they are not persuasive.

Applicant argues that Tallberg et al did not disclose increased expansion.

However, the combined product of Martines-Serna Villagran et al and Tallberg et al would have inherently provided increased expansion due to its higher amylopectin content.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.<sup>6</sup> See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Martines-Serna Villagran et al is directed to a snack food comprising potato flakes with above normal amylopectin content.

In response to applicant's argument that there is no suggestion to combine the

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amylopectin content. Tallberg et al is directed to a type of potato with increased levels of amylopectin. It would have been obvious to one of ordinary skill in the art to incorporate the high amylopectin potato of Tallberg et al into the invention of Martines-Serna Villagran et al since both are directed to food products, since Martines-Serna Villagran et al already taught the use of any commercially available potato (column 4, line 24), since Martines-Serna Villagran et al already used starch with a higher amylopectin content of about 84% (column 7, line 31), since the 100% high amylopectin potato starch of Tallberg et al has not been subjected to chemical modification, making it more suitable as a food ingredient (column 1, lines 37-44), and since the potato of Tallberg et al would have eliminated the need for blanching and pre-conditioning in Martines-Serna Villagran et al. Furthermore, independent claim 18 does not require increased amylopectin. It would have been obvious to one of ordinary skill in the art to incorporate the high amylopectin potato of Tallberg et al into the invention of Martines-Serna Villagran et al.

Applicant argues that Stahl did not disclose increased expansion. However, the combined product of Martines-Serna Villagran et al and Stahl would have inherently provided increased expansion due to its higher amylopectin content.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Martines-Serna Villagran et al teaches the use of any commercially available potato (column 4, line 24), and since the potato of Tallberg et al would have eliminated the need for blanching and pre-conditioning in Martines-Serna Villagran et al, it would have been obvious to one of ordinary skill in the art to incorporate the high amylopectin potato of Tallberg et al into the invention of Martines-Serna Villagran et al.

Applicant argues that Stahl did not disclose increased expansion. However, the combined product of Martines-Serna Villagran et al and Stahl would have inherently provided increased expansion due to its higher amylopectin content.



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Villagran et al is directed to a snack food comprising potato flakes with above normal amylopectin content. Stahl is directed to a type of potato with increased levels of amylopectin. It would have been obvious to one of ordinary skill in the art to incorporate the high amylopectin potato of Stahl into the invention of Martines-Serna Villagran et al since both are directed to food products, since Martines-Serna Villagran et al already taught the use of any commercially available potato (column 4, line 24), since Martines-Serna Villagran et al already used starch with a higher amylopectin content of about 84% (column 7, line 31), since the 95% high amylopectin potato starch of Stahl has not been subjected to chemical modification, making it more suitable as a food ingredient (column 1, lines 37-44), and since the potato of Stahl would have eliminated the need for blanching and pre-conditioning in Martines-Serna Villagran et al. Furthermore, independent claim 18 does not require increased expansion.

### Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone-number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone-number for the organization where this application or proceeding is assigned is 571-273-8300.

*Drew Becker*  
**DREW BECKER**  
**PRIMARY EXAMINER**  
29-06

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